

**OFFICIAL****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

First Named Applicant: Walker	)	Art Unit: 3763
	)	
Serial No.: 09/939,239	)	Examiner: Desanto
	)	
Filed: August 24, 2001	)	001/017 (1-3) USA
	)	
	)	July 27, 2004
	)	750 B STREET, Suite 3120
	)	San Diego, CA 92101
	)	

**RESPONSE TO OFFICE ACTION****RECEIVED  
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Commissioner of Patents and Trademarks  
Washington, DC 20231

**JUL 27 2004**

Dear Sir:

This responds to the Office Action July 13, 2004, which evidently did not consider the preliminary amendment submitted July 7, 2004 adding new claim 38. Because the preliminary amendment was filed before the date of the Office Action, should the present rejections be persisted in, the next Office Action should not be made final.

Claims 5-8, 22-27, and 31-34 have been rejected under 35 U.S.C. §102 as being anticipated by Williams et al., USPN 4,941,475, Bresnahan et al., USPN 6,117,105, and Dae, USPN 6,231,594. Also, Claims 28 and 29 have been rejected as being anticipated by Bresnahan et al. and Dae, and Claim 30 has been rejected as being anticipated by Bresnahan et al. The rejections are traversed for the following reasons.

1. The cumulative anticipation rejections are contrary MPEP §706.02 (rejections should be strictly confined to the best available art. Cumulative rejections should be avoided).

1156-017.AM2

CASE NO.: 001/017  
Serial No.: 09/939,239  
July 27, 2004  
Page 2

PATENT  
Filed: August 24, 2001

2. The citation to the "entire reference" for each of the above-mentioned references in support of the rejections is contrary to the guidance of MPEP §706.02(j) (the Examiner should set forth (1) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate...)

3. The allegation that Williams et al. is a "venous line catheter" is contrary to MPEP §2111.01 (terms must be construed as the skilled artisan construes them), because Williams et al. is placed in the heart to measure cardiac output, and no evidence exists of record that the skilled artisan regards heart-dwelling cardiac output measuring catheters as "venous lines".

4. The filing date (December 4, 1998) of Bresnahan et al. is after the earliest claimed priority date of the present application. It has not been shown that Bresnahan et al. is entitled to the filing date of the provisional from which it claims priority, and MPEP §2136.03(III) (May, 2004 revision) grants a reference the date of an underlying provisional only insofar as the provisional discloses the relied-upon subject matter. Since the Bresnahan et al. provisional application has not been introduced into evidence and since no allegation has been made that the present application is not entitled to its earliest claimed priority date, the rejections based on Bresnahan et al. have been overcome.

5. The filing date (August 11, 1999) of Dae is after the earliest claimed priority date of the present application. Since no allegation has been made that the present application is not entitled to its earliest claimed priority date, the rejections based on Dae have been overcome.

6. The rejections of Claim 5 are contrary to MPEP §2131 and consequently must be withdrawn because they fail to mention the limitation of Claim 5 that the catheter is manufactured by flushing the first

1156-017.AM2

CASE NO.: 001/017  
Serial No.: 09/939,239  
July 27, 2004  
Page 3


PATENT  
Filed: August 24, 2001

lumen from its distal portion to its proximal portion with sterile saline. This is a structural limitation, since it means that residual salt remains in the lumen.

7. The rejections of Claim 22 are contrary to MPEP §2131 because they fail to mention the flow rate range limitation of Claim 22, and consequently must be withdrawn.

The Examiner is cordially invited to telephone the undersigned at (619) 338-8075 for any reason which would advance the instant application to allowance.

Respectfully submitted,

  
\_\_\_\_\_  
John L. Rogitz  
Registration No. 33,549  
Attorney of Record  
750 B Street, Suite 3120  
San Diego, CA 92101  
Telephone: (619) 338-8075

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1156-017.AM2